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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/705,686	11/02/2000	Paul J. Carter	P0709PID3	6821

7590 04/19/2002

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EXAMINER

HELMS, LARRY RONALD

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 04/19/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/705,686

Applicant(s)

CARTER ET AL.

Examiner

Larry R. Helms

Art Unit

1642

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Claims 10-12 are pending.
Claim 10 has been amended.
Claims 10-12 are under examination.
2. The text of those sections of Title 35 U.S.C. code not included in this office action can be found in a prior Office Action.

Information Disclosure Statement

3. The Information Disclosure Statement filed 11/02/00 has been considered. The reference 186 which is a manuscript was considered but will not be printed on the face of the patent should this application be issued. It is not clear that this reference is publicly available. In addition, reference 201 needs a date of publication.

Specification

4. The substitute specification filed 3/18/02 has not been entered because it does not conform to 37 CFR 1.125(b) because: The amendment filed 3/18/02 did not request entry of the substitute specification and the substitute specification does not contain a marked up copy. The substitute specification has been placed in the file.

Rejections Withdrawn

5. The rejection of claims 10-12 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in view of the amendments to the claims and arguments.
6. The rejection of claims 1-12 under 35 U.S.C. 112, first paragraph, is withdrawn in view of the amendments to the claims.

Response to Arguments

7. The rejection of claims 10-12 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 43-105, 115-131 of copending Application No. 08/146,206 is maintained.

The response filed 3/18/02 has been carefully considered but is deemed not to be persuasive. The response states "Applicants ask that it be held in abeyance pending determination that the present claims are otherwise allowable" (see page 5 of response). In response to this argument, the rejection is maintained for reasons of record.

8. The rejection of claims 10-12 under 35 U.S.C. 103(a) as being unpatentable over Hudziak et al (U.S. Patent 5,772,997, priority to 1/25/88, IDS #2) and further in view of Adair et al (WO 91/09667, published 7/11/91, IDS #2) is maintained.

The response filed 3/18/02 has been carefully considered but is deemed not to be persuasive. The response states that the instant application gets a priority date of 6/14/91 as evidenced from the copy of the priority document 07/715,272 supplied with the response of 3/18/02. In response to this argument, supplied with the response filed 3/18/02 is a document for pages 2-17 with no serial numbers or any identifying features to indicate this is the 07/715,272 document. If this document is 07/715,272 then there is no mention of the specific residues indicated in claim 10. As such the instant application is granted the priority date of 6/5/92 and the rejection is maintained.

9. The rejection of claims 10-12 under 35 U.S.C. 103(a) as being unpatentable over Hudziak et al (U.S. Patent 5,772,997, priority to 1/25/88, IDS #2) and further in view of Queen et al (U.S. Patent 5,693,762, priority to at least 2/13/89, IDS #2) and Kabat et al (US Department of Health and Human Services, 1983) is maintained.

The response filed 3/18/02 has been carefully considered but is deemed not to be persuasive. The response states that applicants have supplied a copy of the Queen et al priority document (07/310,252) which demonstrates that the specific residues listed in Table 1 of the issued ,762 patent relied on by the Examiner were not described therein (see page 6 of response filed 3/18/02). In response to this argument, The Queen patent is a CON with a priority date of 12/19/90. As such it is still prior art (as the instant application is granted a priority date of 6/5/92) and discloses the recited residues in claim 10 (see Table 1 of Queen et al).

Conclusion

10. No claim is allowed.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry R. Helms, Ph.D, whose telephone number is (703) 306-5879. The examiner can normally be reached on Monday through Friday from 7:00 am to 4:30 pm, with alternate Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Art Unit: 1642

13. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 308-4242.

Respectfully,

Larry R. Helms Ph.D.

703-306-5879


SHEELA HUFF
PRIMARY EXAMINER